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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,781	10/27/2000	Rene S. Hubert	G&C 129.23-US-U1	6670
36327	7590	04/07/2004	EXAMINER	
AGENSYS C/O MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE, SUITE 500 SAN DIEGO, CA 92130			RAWLINGS, STEPHEN L	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/698,781

**Applicant(s)**

HUBERT ET AL.

**Examiner**

Stephen L. Rawlings, Ph.D.

**Art Unit**

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 58-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 60-63 is/are allowed.
- 6) ☒ Claim(s) 58 and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendment filed March 12, 2003 is acknowledged and has been entered. Claims 58, 60, and 61 have been amended.
2. The grounds of rejection and objection set forth in the Office action mailed February 10, 2003 have been withdrawn.
3. The finality of the Office action mailed February 10, 2004 has been withdrawn so that new ground of rejection may be set forth herein.
4. Claims 58-63 are pending in the application and are currently under prosecution.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 58 is rejected under 35 U.S.C. 102(b) as being anticipated by Database GenEMBL Accession No. HSSPG28, as evidenced by the attached USPTO search report "us-09-698-781-3.olip2n.rge" (result 1).

Claim 58 is drawn to a polynucleotide encoding a SGP28 protein consisting essentially of the amino acid sequence shown in SEQ ID NO: 3 from amino acid 33 to 258.

Database GenEMBL Accession No. HSSPG28 discloses the amino acid sequence of a SGP28 polypeptide, which is encoded by an isolated messenger RNA (mRNA) molecule. The disclosed amino acid sequence comprises amino acids 3-258 of SEQ ID NO: 3.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Database GenEMBL Accession No. HSSPG28 (04 March 1996), as evidenced by the attached USPTO search report "us-09-698-781-3.olip2n.rge" (result 1).

Claim 59 is drawn to a polynucleotide, which is fully complementary to the polypeptide of claim 58.

Database GenEMBL Accession No. HSSPG28 discloses the amino acid sequence of a SGP28 polypeptide, which is encoded by an isolated messenger RNA (mRNA) molecule. The disclosed amino acid sequence comprises amino acids 3-258 of SEQ ID NO: 3.

Principles of Biochemistry, 2<sup>nd</sup> edition, by Lehninger et al. (copyright © 1993 by Worth Publishers, Inc.) teaches the full complement of a nucleic acid molecule encoding a protein can be used as a probe to study the expression of the gene encoding the protein by Northern blot analysis.

Given the disclosure of the prior art and basic knowledge of Northern blot analysis, such as that disclosed in the above referenced Principles of Biochemistry, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to make a polynucleotide, which is fully complementary to the polynucleotide sequence of the mRNA molecule of the prior art, which encodes the SPG28 protein. One of ordinary skill in the art at the time of invention would have been motivated to do so because the polynucleotide could be used as a probe to characterize the expression of the gene encoding the protein.

**Conclusion**

9. Claims 58 and 59 are rejected; claims 60-63 are allowed.

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Database PIR 78 Accession No. S68691, as evidenced by the attached USPTO search report "us-09-698-781-3.rpr" (result 1), discloses the amino acid sequence of a SPG28 protein comprising amino acid 33-258 of SEQ ID NO: 3.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler, Ph.D. can be reached on (571) 272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen L. Rawlings, Ph.D.  
Examiner  
Art Unit 1642

slr  
April 2, 2004

  
YVONNE EYLER, PH.D.  
SUPERVISORY PATENT EXA  
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